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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,279	05/25/2001	Raymond P. Welnicki	21924-005	3606

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EXAMINER
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DASS, HARISH T

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/865,279

Applicant(s)

WELNICKI ET AL.

Examiner

Harish T Dass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/22/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Particularly, Claim 1, "the cost" Claim 1 recites the limitation "the cost" in 8. There is insufficient antecedent basis for this limitation in the claim.

Claims 16-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Particularly, "converter" is not clear, examiner is unable to find a reference in specification which clearly defined "converter" to make proper search.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims Claim 1-2, 4-15 and 3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful,

concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court

found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, Claims Claim 1-2, and 4-15 have no connection to the technological arts. None of the steps indicate any connection to a computer or technology. Therefore, the claims are directed towards non-statutory subject matter.

To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological arts.

However, claim 3 mentions using "a computer network" but it not clear what is performed by computer network?

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-5, 7-9, 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Michael Kane, Jan 15, 1999 "Getting by...with a little help from her friends: UBC library assistant gets some key advice from The Sun's makeover team: Use your RRSP now but claim the refund later; look forward to buying your first car; get to work on making your travel and retirement dreams come true", The Vancouver Sun. Vancouver, B.C. (hereinafter Kane).

Re. Claim 1, Kane discloses identifying a user's desired lifestyle; identifying at least one user preference associated with the desired lifestyle; identifying financial information associated with the user; determining the cost of the user's desired lifestyle, in accordance with the user preference determining whether the desired lifestyle is achievable with respect to the financial information; and, providing a lifestyle plan

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associated with the desired lifestyle and the financial information to the user [see entire document – total of 5 pages].

Re. Claim 2, Kane discloses comprising the step of sending a query to the user to identify at least one of the desired lifestyle, preference, and financial information [see entire document particular pages 2 and 4].

Re. Claim 4, Kane discloses wherein the step of identifying a user's desired lifestyle further comprises identifying a user's desired retirement scenario (various scenarios), [see entire document particular page 3].

Re. Claims 5 and 15, Kane discloses wherein the step of identifying a user's desired lifestyle further comprises identifying at least one of the user's desired place to be, place to go, person to be with, thing to own, and thing to do, and the step of providing the user with the ability to obtain information about at least one aspect of the user's desired lifestyle (goals and visit friends in Australia) [see entire document particular page 3].

Re. Claim 7, Kane discloses 7. The method of claim 1 wherein the step of determining whether the desired lifestyle is achievable comprises comparing the cost of the desired lifestyle to the financial information [see entire document particularly page 1].



Re. Claim 8, Kane discloses comprising the step of providing the cost information to the user (written document) [see page 4].

Re. Claim 9, Kane discloses presenting the user with a suggestion associated with at least one of the desired lifestyle and the financial information (replace car every 10 years) [see entire document particular page 3].

Re. Claims 12-14, Kane discloses wherein the step of identifying financial information associated with the user further comprises querying the user for financial information, identifying financial information associated with the user further comprises retrieving the financial information from a location specified by the user, and retrieving the financial information further comprises retrieving the financial information from a third-party source [see entire document particular page 4].

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 6, 8, and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kane.

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Re. Claim 3, Kane does not explicitly disclose wherein at least a portion of the method is performed using a computer network. However, computer network is known and used by financial advisors and financial institutions to increase productivity using world wide web network for communication and data access from remote computers (servers, database. Etc.) and provide information about verity of financial products to customers. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Kane and include computer network to enable the user and financial advisor/financial institution to communicate with each other using internet to save time and increase efficiency.

Re. Claims 6 and 8, Kane discloses wherein the step of determining the cost of the user's lifestyle further comprises the steps of: determining a cost associated with each user preference [see entire document particular page 3]. Kane does not explicitly disclose summing the costs of each user preference to generate a total cost associated with the desired lifestyle. However, summing cost is known to financial knowledgeable householders/financial advisors/financial institutions. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Kane and include total cost of living for future financial planning and include providing information to customers for their review and comments.

Re. Claims 10-11, Kane does not explicitly disclose step of advising the user to edit at least one of the desired lifestyle and the financial information and providing the user

with the ability to edit at least one of the desired lifestyle and financial information.

However, provide updated information to financial advisors/tax advisors and getting advise from advisor are known to properly project the financial assets and liability numbers which has affect on accurate and updated calculations. For example, a skill financial advisor know more about investment, market and daily events than most people and this is the reason investors go to the to get advise how to mange their portfolios. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Kane and include advising customers to edit/revise their portfolio to achieve best return on investment at a future time.

Claims 18-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maggioncalda et al (hereinafter Maggioncalda - US 5,918,217) in view of Kane.

Re. Claim 18, Maggioncalda disclose a database storing information about at least one type of lifestyle [abstract; Figures 1-5; C5 L20-L22; C5 L63-66; C6 L23 to C7 L5; C15 L50 to C16 L13]; a rules engine defining at least one rule relating to the type of lifestyle [Figure 3 # 330; C7 L37-L48]; and a processor in operable communication with the rules engine and the database, the processor system programmed for [C6 L24-L42].

Maggioncalda does not explicitly disclose receiving user information about a user's desired lifestyle; retrieving data from the database responsive to the user information, in accordance with the at least one rule; and creating a plan for the user to achieve the

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desired lifestyle, in accordance with the retrieved data. However, Kane discloses receiving user information about a user's desired lifestyle; retrieving data from the personal data responsive to the user information, in accordance with the at least one rule; and creating a plan for the user to achieve the desired lifestyle, in accordance with the retrieved data [see entire document total of 5 pages] to provide financial plan a road map to financial security. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Maggioncalda and include lifestyle and goals information, as disclosed by Kane, to provide key advice from financial system/advisor.

Re. Claim 19, Maggioncalda discloses wherein the processor is programmed for providing information to the user that permits the user to explore at least one aspect of the plan [Abstract; Figures 4, 9; C8 L15-L22; C14 L49-L76].

Re. Claim 20, Maggioncalda discloses wherein the processor is programmed to receive user information that includes user financial information [Abstract; Figure 3; C2 L30 to C3 L28].

Re. Claim 21, Kane further discloses wherein the processor is further programmed to retrieve user information from an entity other than the user (account statement) [see entire document particular pages 3-4] to collect investment data for analysis. It would have been obvious at the time the invention was made to a person having ordinary skill

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in the art to modify the disclosure of Maggioncalda and include retrieve user information from an entity other than the user, as disclosed by Kane, to collect investment data for analysis using computer software.

Re. Claim 22, neither Maggioncalda nor Kane explicitly discloses wherein the processor is further programmed to provide at least one of the desired lifestyle, user information, and plan to an entity other than the user. However, this step is well known to financial institutions/agents, which collect public financial information in databases and buy and sell investors information to other financial institutions to make profit buy selling information. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Maggioncalda nor Kane and include wherein the processor is further programmed to provide at least one of the desired lifestyle, user information, and plan to an entity other than the user to make this information available to others who may have a financial product/invest schemes to sell to investors.

Re. Claim 23, Maggioncalda discloses wherein the computerized lifestyle planning system communicates with the user over a computer network [C6 L63 to C7 L5].

Re. Claims 24-28, the claim limitations of these claims are similar to claim 18, therefore these claims are rejected with same rational as 18.

***Conclusion***

*Claims 1-28 are rejected*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

Flora L Williams "Financial counseling: A model for family and consumer sciences professionals", Journal of Family and Consumer Sciences. Alexandria: Winter 1997.Vol.89, Is. 4; pg. 41, 8 pgs [ISSN/ISBN: 10821651 -- ProQuest document ID: 28319380 -- URL: <http://proquest.umi.com/pqdweb?did=28319380&sid=2&Fmt=7&clientId=19649&RQT=309&VName=PQD>

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Souh can be reached on 703-308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass  
Examiner  
Art Unit 3628

*Harish T Dass*

4/7/05